

REMARKS

This Amendment is responsive to the Office Action dated August 11, 2006. Applicant added claim 40, but has not amended any of the previously pending claims with this response. Claims 1, 3, 4, 6-9, 11, 12, 16, 18, 22, 26, 28, 29, 32, 37, 38 and 40 are currently pending.

In the Office Action, the Examiner rejected all pending claims under 35 U.S.C. §103(a) as being unpatentable over Weiner (U.S. Patent Publication No. 2003/0023424) in view of Teicher (U.S. Patent Publication No. 2001/0032070). Applicant respectfully traverses the rejection.

Declaration Under 37 C.F.R. 1.131 Submitted With This Response

A Rule 131 Declaration by the inventor, Robert D. Palmquist, is being submitted with this response. The Declaration specifically applies with respect to claims 1, 3, 4, 6, 7, 9, 16, 18, 22, 26, 28, 29, 32, 37 and 38. The Declaration establishes the following:

- 1) Robert D. Palmquist conceived of the claimed invention recited in claims 1, 3, 4, 6, 7, 9, 16, 18, 22, 26, 28, 29, 32, 37 and 38 prior to July 30, 2001, the priority date of Weiner.
- 2) Robert D. Palmquist, and other Speechgear employees actually reduced to practice the claimed inventions of claims 1, 3, 4, 16, 18, 26, 28, 29, 32 and 37 on or before November 26, 2001.
- 3) Robert D. Palmquist, and other Speechgear employees worked diligently between July 30, 2001 and November 26, 2001 to actually reduce the inventions of claims 1, 3, 4, 16, 18, 26, 28, 29, 32 and 37 to practice.
- 4) The filing date of the current application (December 21, 2001) provides a constructive reduction to practice of the inventions recited in dependent claims 6, 7, 9, 22 and 38.
- 5) Robert D. Palmquist, and other Speechgear employees worked diligently between July 30, 2001 and December 21 toward the constructive reduction to practice of the inventions of claims 6, 7, 9, 22 and 38.

On the basis of the Declaration, Applicant submits the claimed invention was clearly conceived prior to the priority date of the Weiner reference, and diligently reduced to practice from a time prior to the priority date of the Weiner reference. As further proof of diligence,

Applicant also refers the Examiner to the Rule 131 Declaration previously filed in this application, which established attorney diligence for at least a period prior to December 2001 to the filing date on December 21, 2001.

Claims 8 and 11

With respect to the remaining claims 8 and 11 that are not currently covered by the attached Declaration, Applicant traverses the rejections and submits that Weiner in view of Teicher would not have made the specific features of these dependent claims obvious to one of ordinary skill in the art at the time of Applicant's invention for at least the reason that Weiner and Teicher do not disclose each of the elements required by claim 8 or by claim 11.

Claim 8 is dependent upon 6 and further requires displaying one of the translation of the first text and the translation of the second text in response to a command from a user. Claim 6 is dependent on claim 1 and further requires transmitting a second image containing second text in the first language over the network and receiving a translation of the first text and the second text in the second language over the network. Because these specific features are not disclosed or suggested in either Weiner or Teicher, the subject matter of claim 8 would not have been obvious to one of ordinary skill in the art.

In the rejection of claim 6, the Examiner cited Teicher para. [0021] as disclosing the specific features recited in claim 6. However, para. [0021] of Teicher only discusses a single image and not a second image containing second text in the first language as required by claim 6. The Examiner provided no further support for the proposition that this feature is disclosed by either Weiner or Teicher and Applicant failed to find any further support. For at least this reason, the Examiner should withdraw the rejection of claim 8, which is dependent on claim 6.

Claim 8 recites additional features not found in Weiner or Teicher. In the rejection of claim 8, the Examiner cited Teicher FIG. 3C as disclosing the specific features recited in claim 8. However, FIG. 3C of Teicher shows a translation ("THANK YOU") of a word in a single image ("MERCI") superimposed on the image. In contrast, claim 8 requires displaying one of the translation of the first text and the translation of the second text in response to a command from a user. In no way does FIG. 3C suggest a command from a user, much less a command that results in a response to displaying one of the translation of the first text and the translation of the second

text as recited by claim 8. The Examiner provided no further support for the proposition that this feature is disclosed by either Weiner or Teicher, and Applicant failed to find any further support. Because specific features required by claim 8 are not disclosed or suggested in either Weiner or Teicher, the Examiner should withdraw the rejection of claim 8.

Claim 11 is dependent upon claim 1 and further requires prompting a user to provide additional information comprising at least one of an account number, a password, an identification of the first language, and identification of the second language, a dictionary and a server location. In the rejection of claim 11, the Examiner stated that such a feature is inherent to the translation to a language.

However, techniques for translation as recited in claim 1 can certainly occur without prompting a user to provide additional information comprising at least one of an account number, a password, an identification of the first language, and identification of the second language, a dictionary and a server location. For example, translation may occur immediately after a user sends an image including text to a server.

Inherency requires that one skilled in the art would necessarily understand the applied reference to include the missing disclosure.¹ The mere possibility that one skilled in the art might interpret a general disclosure as including undisclosed features is insufficient to show inherency.² Translation may occur without prompting a user to provide additional information, one of ordinary skill in the art **would not necessarily** have understood prompting a user to provide additional information to be included within the cited references. For this reason, the elements of claim 11 can not be said inherent to the combined teachings of Weiner and Teicher.

In sum, Weiner or Teicher fail to disclose every element of claim 11, and Applicants respectfully submit that the Examiner's reliance on the doctrine of inherency to overcome this failure is misplaced. Because claim 11 includes specific features are not disclosed or suggested in either Weiner or Teicher, the subject matter of claim 11 would not have been obvious to one of ordinary skill in the art.

¹ See *Finnigan Corp. v. ITC*, 51 USPQ2d 1001, 1009 (Fed. Cir. 1999) (emphasis added).

² See *id.* (emphasis added).

Because the cited references fail to disclose each and every feature of the invention as recited in claims 8 and 11, claims 8 and 11 would not have been obvious to one of ordinary skill in the art at the time of Applicant's invention. Applicant respectfully requests withdrawal of the rejection of claims 8 and 11 under 35 U.S.C. §103(a).

New Claims

Applicant has added claim 40 to the pending application. The applied references fail to disclose or suggest the inventions defined by Applicant's new claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed inventions. No new matter has been added by the new claims.

New claim 40, for example, finds support from the second paragraph from the Summary. New claim 40 also finds support in the second full paragraph of page 6 of the Specification.

CONCLUSION

Applicant does not acquiesce in any of the Examiner's rejections, nor any characterization of the scope and content of the Weiner reference. In view of the Declaration and Exhibits, however, Applicant respectfully submits that the Weiner reference does not qualify as prior art to claims 1, 3, 4, 6, 7, 9, 16, 18, 22, 26, 28, 29, 32, 37 and 38. Also, the specific features of claims 8 and 11 would not have been obvious to one of ordinary skill in the art at the time of Applicant's invention from Weiner in view of Teicher. For these reasons, Applicant requests that all pending rejections be withdrawn.

Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

Feb. 1, 2007

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